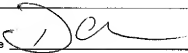


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number 1111 008 301 0252
	Application Number 10/074,992	Filed February 13, 2002
First Named Inventor William Alan Burris		
Art Unit 1744		Examiner K. Jastrzab
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p><u>The review is requested for the reason(s) stated on the attached sheet(s).</u> Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 34,545</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</p> <p><input type="checkbox"/> Registration number if acting under 37 CFR 1.34</p> </div> <div style="width: 35%;"> <p>Signature <u></u></p> <p>Typed name Duane C. Basch</p> <p>Telephone number 585-899-3970</p> <p>Date <u>8/2/06</u></p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>		
<p>Total of _____ forms are submitted.</p>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

ARGUMENTS TO BE CONSIDERED BY PRE-APPEAL BRIEF CONFERENCE
PANEL

Rejection: Claims 1-5 and 7-31 remain rejected under 35 USC §103(a) as being unpatentable over Contreras in view of Burris '993. Claims 1-5 and 7-31 also remain rejected under 35 USC §103(a) as being unpatentable over Engelhard et al. in view of Burris '993.

Errors in Rejection: Claims 1-5 and 7-31 are not properly rejected under 35 USC §103(a) as being unpatentable over Contreras in view of Burris '993, or as being unpatentable over Engelhard et al. in view of Burris '993, as *prima facie* obviousness has not been established in either rejection.

Contreras in view of Burris '993

Contreras discloses keeping a storage tank of water and a device for introducing ozone into the water in the storage tank (e.g., Abstract) and further discloses continuously ozonating and circulating the ozonated water (col. 2, lines 18-20; col. 3, line 57 – col.4, line 8). Contreras teaches at column 4, lines 5-15 that “actively ozonated water is to flow from the tap,” and that excess ozone is handled by “flexible tube 26 connected ... and fed into the storage tank 2 so that the hose [flexible tube 26] is positioned near the bottom of the lid 9 to capture and reuse any excess ozone, thus leaving no waste.” As noted by the Examiner “active” means water containing ozone in its active state. Contreras suggests that ozone is discharged with the treated water from the tap (col. 2, lines 25-27), which is contrary to, and teaches away from, the vent and reducing system presently claimed. Based on this information Appellants urge that one skilled in the art could only conclude that Contreras teaches that ozone is output with the water. Accordingly, Contreras teaches away from the recited limitations of independent claim 1, requiring “a separation system that separates undissolved gas from the ozonated liquid prior to circulating the ozonated liquid through the circulation passageway; a reducing system that prevents ozone in the separated gas from escaping into the atmosphere by passing the gas through an ozone reducing material before venting” (underlining added).

The rejection also continues to rely upon the teachings of Burris '993, although Burris '993 discloses a batch system for disinfection of a liquid. In the Advisory Action the

Examiner alleges that Contreras' teaching periodic or continuous application of ozone is suggestive of a batch system, yet ignores Contreras' teaching of immediate replenishment of any water used (col. 2, lines 53-55) – which is simply not a batch processing system. Burris '993 is directed to equipment for purifying batches of liquid with ozone - when the liquid is allowed the time for purification to take place.

Thus, Burris '993 does not appear to disclose the output of a disinfecting liquid as does Contreras. In response the Examiner urges that the teachings of Burris '993, particularly col. 2, lines 39-40, suggest the same. However, when read in context, the language cited by the Examiner clearly indicates it is the water or liquid that is to be purified or disinfected, not that the water is used for disinfection. Furthermore Burris '993 indicates that it is undesirable to vent ozone directly to the atmosphere without changing it to oxygen (col. 3, lines 24-27). Burris '993 makes it clear that liquid cannot enter the ozone reducer 23 (col. 3, lines 44-56).

In response to Appellant's prior questioning of the motivation to combine and modify the teachings of the referenced patents, the Examiner stated that the motivation "is to protect users of the system in the case of an emergency or maintenance shutdown of the system." (Final Office Action, p. 5) Appellants were unable to identify where the Examiner finds such motivation, and the Examiner now suggests a "common sense" motivation - apparently ignoring Contreras' teaching of dispensing actively ozonated liquid. At best Appellants understand that Contreras makes no mention of the need or desirability to vent or reduce ozone. Nonetheless, the Examiner, while acknowledging that Contreras' teaching of reusing the excess ozone collected through hose 26 is different than venting, further seeks to base the rejection on an unsupported conclusion of the alleged obviousness to replace the old ozone with new ozone. Appellants respectfully urge that the Examiner has provided no support for such a conclusion. It is, therefore, apparent that the Examiner is relying upon the claim limitations of the present application as the basis for making the proposed combination. *Prima facie* obviousness may not be established by relying on the teachings of Appellants' claims.

Moreover, the previously alleged reason for the combination also admitted to Contreras' contrary teachings – indeed it appears to "allow for ... natural dissipation of the off-gas as required by return of the off-gas to the reservoir." Why would one of skill in the art be motivated to provide the reduction and venting of the Burris '993

batch system if Contreras is indeed returning gas to the reservoir and allowing for its natural dissipation?

Appellants further submit that the standard for obviousness is that “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art,” not “well within the purview of one of ordinary skill in the art” as set forth in the Final Office Action.

Considering, *in arguendo*, the combination of Contreras in view of Burris ‘993, Appellants contend that, at best, the arguable combination fails to teach a circulation system that circulates liquid containing dissolved ozone and a separation system that separates undissolved gas from the ozonated liquid prior to circulating the ozonated liquid through the circulation passageway – neither of the patents relied upon expressly indicate such a feature. Accordingly, claim 1 is patentably distinguishable over the arguable combination of Contreras in view of Burris ‘993 and the rejection is traversed.

Appellants note that several prior responses set forth, in detail, Appellants’ position relative to claims dependent from claim 1. For purposes of brevity the distinctions of the dependent claims are not set forth again, and Appellants respectfully urge such dependent claims are also allowable for the reasons set forth relative to claim 1 above. Appellants also acknowledge that the Advisory Action sets forth, for the first time, specific sections relied upon for teaching the recited limitations and Appellants request an opportunity to address such teachings in a non-final Office Action, and otherwise reserve the right to address such rejections, including the alleged intrinsic and inherent teachings, in their Appeal Brief.

Engelhard et al. in view of Burris ‘993

Claims 1 – 5 and 7 – 31 also remain rejected under 35 USC §103(a) as being unpatentable over Engelhard et al. in view of Burris ‘993. Appellants continue to urge that the rejection improperly relies on teachings from Contreras for the suggestion that a UV ozone generator may be substituted for a corona generator. The Advisory Action sets forth the Examiner’s reliance on Contreras as indicating the state of the art. Yet the Examiner uses the teachings of Contreras to suggest the modification of Engelhard (i.e., as the basis to urge the substitution of one generator for the other). Appellants again submit that Contreras has not been set forth in the rejection, and

that reliance upon Contreras is improper unless set forth and it is further shown to have been obvious to make the proposed modification. Absent such teachings, Appellants again urge that *prima facie* obviousness has not been established, and the rejection is respectfully traversed.

Appellants, in response to the Examiner's Advisory Action remarks, continue to maintain that in spite of the fact that both types of generators may produce ozone, it is not obvious to make the proposed substitution as to do so would either impact the performance of the device or would require an entirely redesigned system (see Exhibit submitted with Response After Final), thereby not being an obvious substitution. Appellants maintain that one skilled in the art would not have been motivated to substitute the UV generator taught by Engelhard with the corona discharge generator of Burris '993; the change in concentrations of ozone produced would require significant alterations to the designs of such systems. Absent a specific teaching to suggest the proposed substitution, Appellants respectfully urge that the present claims are again being used as the "recipe" from which elements of unrelated systems are urged for combination and modification. Accordingly, Appellants respectfully traverse the rejection.

Considering the rejection over the arguable combination of Engelhard et al. in view of Burris '993, Engelhard is directed to an ozone generator that provides an outflow of ozone enriched air introduced to a water source through a sparger. The ozonated water is conveyed through water lines to each of the various handpieces or implements used by a dentist during the normal course of providing dental services. Engelhard, like Contreras, also relies on the circulation of ozonated water having undissolved ozone gas therein. Moreover, the statement that the water kills living organisms and biofilms confirms this. As noted above, such a teaching is contrary to Burris '993 (no circulation of ozone gas in water), and Appellants respectfully urge that the patents are not properly combined.

Appellants further submit that the rejections set forth in the Office Action are again incomplete relative to the dependent claims. Again due to the requisite brevity of these remarks, Appellants cannot set forth the errors in the rejection of each of the dependent claims. Nonetheless, Appellants note that the Advisory Action, for the first time, indicates those portions of Burris '993 relied upon as teaching the dependent claim limitations. Furthermore, the Advisory Action indicates that the Examiner relies

upon Burris '993 as the basis for rejecting claims 8, 14, 16-17, 19, 23 and 25, but ignores the limitations of the other dependent claims (e.g., claims 27-29) - or perhaps relies upon Contreras as the basis for such rejections? Yet Contreras has not been applied to the current rejection. Thus, some of the dependent claims are either clearly allowable over the rejection based upon Engelhard in view of Burris '993, or the rejection is incomplete in failing to indicate its reliance on Contreras as well. In any event, Appellants urge that *prima facie* obviousness has not been established relative to the limitations of all the dependent claims.

Conclusion: in view of the reasons for traversal set forth above, and as further set forth in Appellants Response After Final submitted June 5, 2006, the Pre-Appeal Brief Conference Panel is respectfully requested to reconsider and instruct the Examiner to withdraw the present rejections in their entirety, or to at least set forth complete, *prima facie* rejections to which Appellants can respond.

Respectfully submitted,



Duane C. Basch
Attorney for Appellants
Registration No. 34,545

Basch & Nickerson LLP
1777 Penfield Road
Penfield, New York 14526
(585) 899-3970